

REMARKS

I. Introduction

Claims 1, 3 to 24, and 26 to 36 are currently pending and being considered in the present application. Claims 20, 30, and 33 have been amended. No new matter has been added. Approval and entry of the amendments to the claim are therefore respectfully requested. However, even should the Examiner decline to enter the amendments, Applicants request that: (1) the Examiner still indicate whether the proposed amendments would place the claims in better condition for allowance and/or in better condition for appeal, e.g., in view of the references that have already been cited, as suggested by *M.P.E.P.* § 714.13(III); and (2) to the extent the rejections of claims are maintained, the Examiner still address each of Applicants' arguments presented below which are not dependent upon such non-entered amendments, so that any grounds of rejection are "clearly developed to such an extent that applicant may readily judge the advisability of an appeal," as required by *M.P.E.P.* § 706.07(a).

In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1, 3 to 8, 12 to 17, 24, 26, 28, 29, 34, and 35 Under 35 U.S.C. § 103(a)

Claims 1, 3 to 8, 12 to 17, 24, 26, 28, 29, 34, and 35 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent Application Publication No. 2003/0146940 ("Ellis et al.") and U.S. Patent Application Publication No. 2003/0177495 ("Needham et al."). It is respectfully submitted that the combination of Ellis et al. and Needham et al. does not render unpatentable the present claims for at least the following reasons.

Claim 1 relates to a method for displaying a media guide to a user, and recites, *inter alia*, the following:

displaying the set of recommended titles in a single integrated list, the set of recommended titles including a title of at least one of the programs immediately available to the user via download or data streaming, a title of at least one of the programs that have been previously stored locally relative to the user, and a title of at least one of the programs that are immediately available to the user via television broadcast.

As noted in Applicants' Amendment dated August 10, 2009, Ellis et al. do not disclose or suggest these features. Instead, Ellis et al. refer to displaying only television broadcast program information on a single display page generated based on a user profile. *See* Ellis et al., e.g., figures 6, 7, 8a, 8b, 8c, 11, 16a, 16b, and 16c. Indeed, the Office Action at page 3 admits this critical deficiency of Ellis et al. Specifically, Needham et al. merely refer to displaying past, current, and future broadcast programs for selection by the user to have the programs recorded. *See* Needham et al., ¶ [0015], lines 7 to 10; and ¶ [0023], lines 11 to 15. Therefore, the list of Needham et al. would not include those programs that have already been recorded.

In the "Response to Arguments" section, the Office Action asserts that ¶ [0025] of Needham et al. states that selection of a program for recordation does not result in its removal from the list, but rather merely causes a change to its displayed color. Applicants respectfully disagree.

¶ [0025] does not make such a statement and does not at all refer to programs that have been recorded. Rather, ¶ [0025] refers to display in different colors depending on the status of the program's availability for download (for example, depending on copyright restrictions) or the cost of such download.

The Advisory Action incorrectly states that since Needham et al. does not explicitly state that a program listing is removed from its EPG, therefore "a previously recorded program will be displayed by the EPG shown in fig. 1." Silence by Needham et al. as to whether the a program is removed from the EPG subsequent to its recordation in no way is disclosure of its continued display.

Moreover, even if Needham et al. has disclosed that its EPG listing includes previously recorded programs (which it plainly does not), since the EPG listing of Needham et al. is not of recommended titles, the resulting listing would still not disclose or suggest the integrated list of recommended titles of claim 1, nor would there be any suggestion to modify a list of recommended titles to include titles of previously recorded programs. In this regard, a list of recommended titles is generated to limit the listings to only those which are recommended. One of ordinary skill in the art would not have modified such a limited list to be expanded to include listings of previously recorded programs because characteristics of recorded programs are conventionally thought to be known to the user since they are already "owned" and previously selected programs, and thus one would not have thought there to be any need for them to be further recommended.

The Advisory Action asserts that the claim does not preclude adjacent display of two different lists, one including recommended titles and one including previously recorded titles. Claim 1 has been clarified to refer to filtering the programs that have been previously stored locally for obtaining the set of recommended titles. As explained above, the combination of Ellis et al. and Needham et al. does not disclose or suggest this feature.

Thus, even if the list of Ellis et al. is modified to include the features of the list of Needham et al., the modified list would still not disclose or suggest the features of claim 1.

Therefore, the combination of Ellis et al. and Needham et al. does not disclose or suggest all of the features of claim 1, and therefore does not render unpatentable claim 1 or any of its dependent claims, e.g., claims 3 to 8, 12 to 17, and 34.

Claim 24 includes subject matter analogous to that of claim 1, so that the combination of Ellis et al. and Needham et al. does not render unpatentable claim 24 or any of its dependent claims, e.g., claims 26, 28, 29, and 35, for at least essentially the same reasons set forth above in support of the patentability of claim 1.

Withdrawal of this obviousness rejection of claims 1, 3 to 8, 12 to 17, 24, 26, 28, 29, 34, and 35 is therefore respectfully requested.

III. Rejection of Claims 9 to 11, and 27 Under 35 U.S.C. § 103(a)

Claims 9 to 11, and 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Ellis et al., Needham et al., and U.S. Patent Application Publication No. 2003/0005429 (“Colsey”). It is respectfully submitted that the combination of Ellis et al., Needham et al., and Colsey does not render unpatentable the present claims, and the present rejection should be withdrawn, for at least the following reasons.

Claims 9 to 11 ultimately depend from claim 1, and claim 27 depends from claim 24, so that these dependent claims are allowable for at least the same reasons set forth above in support of the patentability of claims 1 and 24, respectively, since Colsey does not cure the critical deficiencies noted above with respect to the combination of Ellis et al. and Needham et al.

Withdrawal of this obviousness rejection of claims 9 to 11 and 27 is therefore respectfully requested.

IV. Rejection of Claims 18 and 19 Under 35 U.S.C. § 103(a)

Claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Ellis et al., Needham et al., and U.S. Patent Application Publication No. 2003/0005445 (“Schein et al.”). It is respectfully submitted that the combination of Ellis et al., Needham et al., and Schein et al. does not render unpatentable the present claims for at least the following reasons.

Claims 18 and 19 depend from claim 1, so that these dependent claims are allowable for at least the same reasons set forth above in support of the patentability of claim 1, since Schein et al. do not cure the critical deficiencies noted above with respect to Ellis et al. and Needham et al.

Withdrawal of this obviousness rejection of claims 18 and 19 is therefore respectfully requested.

V. Rejection of Claims 20 to 23, and 30 to 33 Under 35 U.S.C. § 103(a)

Claims 20 to 23, and 30 to 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,515,680 (“Hendricks et al.”) and Ellis et al. It is respectfully submitted that the combination of Hendricks et al. and Ellis et al. does not render unpatentable the present claims, and the rejection should be withdrawn, for at least the following reasons.

Claim 20 relates to a method of displaying a program guide to a user, and, as herein amended without prejudice, recites, *inter alia*, the following:

- . . . a) receiving information from a programming provider that indicates suggested media programs . . .*
- c) displaying, on a single page and in a first list, titles of at least some of the suggested media programs;*
- d) displaying, on the single page in a second list, titles of at least some media programs that are immediately available to the user and that meet at least one of the user preferences, a separation of the first and second lists being demarcated; and*
- e) displaying a single filter bar including a plurality of filter-specification buttons, wherein, for each of the buttons, selection of the button causes a respective type of filtering of both of the first and second lists.*

Thus, claim 20 refers to providing a single page with different types of recommended titles, a first type being predominantly user-preference driven and a second type being predominantly provider-suggestion driven. The user is thereby given an array of recommendation information from which to choose, while, at the same time, not being confused by integration of such different types of recommendations due to the demarcated

separation of the two lists. Moreover, both lists are user controllable by selection of filter buttons for responsively filtering both lists. Thus, both lists are provided as primary recommendation lists.

The Office Action at page 11 admits that “Hendricks does not specifically disclose . . . d) displaying in a second list, titles of at least some media programs that are immediately available to the user and that meet at least one of the user preferences,” and instead refers to figure 16a of Ellis et al. as assertedly disclosing a single page having the two types of lists of claim 20. Specifically, the Office Action refers to the program listing schedule of figure 16a as assertedly disclosing the first list of claim 20 and to the selectable advertisements of figure 16a as assertedly disclosing the second list of claim 20. However, advertisements are presented in a manner which is clearly different than the scheduling information, such that it is clearly incidental to the primary listing which is the scheduling information. In this regard, interaction with the advertisements and scheduling information differs, the main intended interaction being with the schedule, while interaction with the advertisements moves the graphical user interface display to a different page. In contrast, claim 20 provides for interaction with the first and second lists in the same manner, and, even more, provides that a single interaction with the interface affects the displays of both the first and second lists.

The cited references, whether considered alone or in combination, do not disclose or suggest such a display of two primary lists with which simultaneous interaction is provided.

Accordingly, the combination of Hendricks et al. and Ellis et al. does not disclose or suggest all of the features of claim 20, and therefore does not render unpatentable claim 20 or any of its dependent claims 21 and 22.

As further regards claim 22, the claim provides that although population of the second is predominantly based on user preferences, titles of programs that do not meet the user preferences are pushed through into the list based on a promotional priority, even though another list of programs, i.e., the first list, whose suggestion information is obtained from the programming provider is also displayed. The Office Action does not directly address claim 22, but instead refers to the rejection of claim 8, with respect to which the Office Action refers to the selectable advertisements in figure 16a of Ellis et al. However, the Office Action relies on those advertisements as disclosing the first list which is demarcated from the second list. Therefore, those advertisements cannot also be relied upon for disclosing the promotional priority based listings in the second list of claim 22. Indeed, nowhere do the

cited references disclose or suggest this feature of claim 22. For this additional reason, the combination of Hendricks et al. and Ellis et al. does not render unpatentable claim 22.

Claim 23 relates to a method of displaying a program guide to a user, and recites, *inter alia*, the following:

*... receiving titles of, and respective metadata associated with, available media programs, the respective metadata including a respective indication of a priority of a programming provider; ...
displaying, on a single page and in a first list, a first title of at least one of the available media programs [based on] at least one of the user preferences; and
based on the respective indications of a priority, selecting, for inclusion in a second list, a second title of at least another of the available media programs, and displaying the second list in the single page even if the respective metadata associated with the at least another of the available media programs does not match at least one of the user preferences ...*

The Office Action refers figure 16a of Ellis et al. as assertedly disclosing the first and second lists of claim 23, but does not specify which parts of figure 16a are relied upon for disclosing the first and second lists. Apparently, the Office Action intends to refer to the program listing schedule of figure 16a as assertedly disclosing the first list and to the selectable advertisements of figure 16a as assertedly disclosing the second list. However, the selectable advertisements are not indicated to be displayed based on a received indication of priority. Accordingly, figure 16a of Ellis et al. does not disclose or suggest the first and second lists of claim 23.

The Advisory Action refers to figures 16 and 17 of Hendricks et al. as assertedly disclosing display of an advertisement based on a programming provider's priority and to the modification of the selectable advertisement of figure 16b of Ellis et al. to include the advertisement of Hendricks et al. as assertedly disclosing the second list. However, for example, paragraph 110 of Ellis et al. states that user preferences may be used to target the advertisements. Neither reference suggests displaying an advertisement selected based on a provider's preference in the same page as one displaying a list of titles filtered based on user preference, even in an instance where the advertisement does not match the user preferences, as required by claim 23.

Moreover, with respect to the advertisements of figures 16 and 17 of Hendricks et al., nowhere do Hendricks et al. state that they are selected for display based on priority indications provided in metadata concerning the advertised programs, as required by claim 23. Therefore, even if the system of Ellis et al. is modified to include the advertisement

of figures 16 and 17 of Hendricks et al., the modified system would still not disclose or suggest the features of claim 23.

Therefore, the combination of Hendricks et al. and Ellis et al. does not disclose or suggest all of the features of claim 23, and therefore does not render unpatentable claim 23.

Claim 30, as herein amended without prejudice, includes subject matter analogous to that of claim 20. Therefore, claim 30 and its dependent claims 31 and 32 are allowable for at least the same reasons as claim 20.

As further regards claim 32, the claim includes subject matter analogous to that of claim 22 and is therefore allowable for at least the same additional reason as claim 22.

Claim 33 includes subject matter analogous to that of claim 23 and is therefore allowable for at least the same reasons as claim 23.

Withdrawal of this obviousness rejection of claims 20 to 23 and 30 to 33 is therefore respectfully requested.

VI. Rejection of Claim 36 Under 35 U.S.C. § 103(a)

Claim 36 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Ellis et al., Needham et al., and U.S. Patent Application Publication No. 2002/0144264 (“Broadus”). It is respectfully submitted that the combination of Ellis et al., Needham et al., and Broadus does not render unpatentable claim 36, and the rejection should be withdrawn, for at least the following reasons.

Claim 36 includes subject matter analogous to that discussed above in support of the patentability of claim 1 and is therefore allowable for at least the same reasons as claim 1, since Broadus does not correct the critical deficiencies of the combination of Ellis et al. and Needham et al. noted above with respect to claim 1.

Withdrawal of this rejection of claim 36 is therefore respectfully requested.

VII. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: April 16, 2010

By: /Aaron Grunberger/
Aaron Grunberger
Reg. No. 59,210

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO 26646